

REMARKS

Applicants respectfully request further examination and reconsideration in view of the instant response. Claims 1-26 remain pending in the case. Claims 1-26 are rejected. Claims 1-13 are amended herein. No new matter has been added.

REQUEST FOR ENGLISH TRANSLATION OF CITED JAPANESE PATENT REFERENCE

For the second time during the prosecution of the current patent application, Applicants respectfully request an English translation of the cited non-English reference, Japanese Patent 403010379 by Mihata et al., hereinafter referred to as the "Mihata" reference.

Applicants respectfully point out that the only text in support of the rejection based in part on Mihata is based solely on the Abstract of Mihata, which is the only portion of Mihata translated into English. Applicants respectfully assert that the Manual of Patent Examining Procedure (MPEP) requires that "[i]f the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that it is clear as to the precise facts the examiner is relying on in support of the rejection" (MPEP 706.02 II., emphasis added). "Citations of an abstract without citation and reliance on the underlying scientific document itself is generally inappropriate where both the abstract and the underlying document are prior art. ... It is our opinion that a proper examination under 37 CFR §1.104 should be based on the underlying documents and translations, where needed. Accordingly, the preferred practice is for the examiner to cite and rely on the underlying document." *Ex parte*

Jones, 62 USPQ2d 1206, 1208 (B.P.A.I. 2001). “In our view, obtaining translations is the responsibility of the examiner. A review by the examiner and applicant of translations of the prior art relied upon in support of the examiner’s rejection may supply additional relevant evidence as to whether there is a legally sufficient reason, suggestion, teaching or motivation to combine the teachings” *Ex parte Jones*, 62 USPQ2d 1206, 1208-09 (B.P.A.I. 2001); MPEP 706.02 (emphasis added).

In the event that Mihata is again cited by the Examiner in rejecting the claims, in order to fully appreciate the scientific teachings of Mihata, Applicants request that the Examiner provide a complete translation of Mihata in order to fully understand its teachings.

35 U.S.C. §101

Claims 1-13 are rejected under 35 U.S.C. § 101 as the Examiner asserts that the claimed invention is directed to non-statutory subject matter. Applicants have amended Claims 1-13 to recite “A computer-implemented method,” as suggested by the Examiner (emphasis added). As amended, Claims 1-13 recite a limitation in the technological arts, specifically, a computer-implemented method. Applicants respectfully submit that Claims 1-13 recite a limitation that suggests a computer or data processing device is used to carry out the recited method. Therefore, Applicants respectfully submit that Claims 1-13 overcome the rejection under 35 U.S.C. § 101.

35 U.S.C. §103(a) - 1-3, 5-15 and 17-26

Claims 1-3, 5-15 and 17-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent 6,059,842 by Dumarot et al., hereinafter referred to as the "Dumarot" reference, in view of United States Patent 6,505,249 by Rehkopf, hereinafter referred to as the "Rehkopf" reference. Applicants have reviewed the cited reference and respectfully submit that the embodiments of the present invention as recited in Claims 1-3, 5-15 and 17-26 are patentable over Dumarot in view of Rehkopf.

Applicants respectfully direct the Examiner to independent Claim 1 that recites that an embodiment of the present invention is directed to (emphasis added):

A computer-implemented method for enhancing performance of a computer system, comprising:
electronically deriving relationships over time between monitored system variables and monitored performance of said computer system;
automatically generating a number of rules based on said derived relationships, wherein said number of rules are generated without requiring human interaction; and
adjusting at least one of said system variables based on said generated number of rules to enhance the performance of said computer system.

Independent Claims 12, 14 and 24 recite similar limitations. Claims 2,3 and 5-11 that depend from independent Claim 1, Claim 13 that depends from independent Claim 12, Claims 15 and 17-23 that depend from independent Claim 14, and Claims 25 and 26 that depend from independent Claim 24 provide further recitations of the features of the present invention.

Dumarot and the claimed invention are very different. Applicants understand Dumarot to teach a system and method for optimizing computer software and hardware according to user-specified preferences (Abstract; col. 3, lines 10-13; and col. 3, lines 41-45). In particular, Dumarot teaches that rules are used to make the optimizations, wherein the rules are selected according to a user selection and wherein the rules define variable relationships. The computer optimization system as taught by Dumarot does not teach, describe or suggest “electronically deriving relationships over time between monitored system variables and monitored performance of said computer system,” or “automatically generating a number of rules based on said derived relationships, wherein said number of rules are generated without requiring human interaction,” as claimed (emphasis added).

Examiner cites Dumarot as teaching electronically deriving relationships at col. 7, lines 5-16 and 25-35. In particular, with reference to Figure 5, Examiner asserts that the optimizer contains rules 331, 341 and 351 that are used for making optimizations 330 and 340, and recommendations 350, respectively (col. 7, lines 25-27). Applicants understand the rules to be preconfigured and are selected according to a user's interaction with a graphical user interface (GUI). For example, the rule “If A1=yes, and S1=200 MHz, or Mi=90%” defines a relationship between conditions for optimizing settings of a graphics card. In particular, the relationships defined in the rule are user defined and, accordingly, are not derived over time. Applicants respectfully assert that the rules of Dumarot are not based on derived relationships between system variables and the performance of the computer.

In contrast, embodiments of the claimed invention are directed towards a method for enhancing performance of a computer system, including “electronically deriving relationships over time between monitored system variables and monitored performance of said computer system,” as claimed (emphasis added). With reference to the present specification, data for system variables and system performance is acquired over time (page 9, lines 15-22). With reference to Figure 5 of the present application, a number of rules 500-502 are generated based on an analysis of acquired data for system variables and system performance, and the derived relationships therebetween (page 14, lines 7-16). The rules are generated based on an analysis data acquired (page 13, lines 7-22). In particular, the relationships are derived between system variables and the performance of the computer system, and are not user-defined.

Applicants respectfully assert that Dumarot in particular does not teach, disclose, or suggest “electronically deriving relationships over time” as claimed. In contrast, Dumarot discloses a system and method for optimizing computer software and hardware according to user-defined rules, where the relationships between conditions of the rules are defined by the user. By teaching a system that utilizes and requires a user to select and define rules, Dumarot teaches away from the claimed invention of “electronically deriving relationships over time”.

Examiner states that Dumarot does not teach “automatically generating a number of rules based on said derived relationships, wherein said number of rules are generated without requiring human interaction,” as claimed. Examiner submits that

Rehkopf provides such a teaching, and that the combination of Dumarot and Rehkopf would have been obvious to one of skill in the art at the time the invention was made.

Applicants respectfully assert that the combination of Dumarot and Rehkopf fails to teach or suggest the claimed embodiments because Rehkopf does not overcome the shortcomings of Dumarot. Applicants understand Rehkopf to teach a design rules verifying system. Rehkopf, alone or in combination with Dumarot, does not show or suggest a method for enhancing performance of a computer system, including “electronically deriving relationships over time between monitored system variables and monitored performance of said computer system,” or “automatically generating a number of rules based on said derived relationships, wherein said number of rules are generated without requiring human interaction,” as claimed.

Rehkopf and the claimed invention are very different. Applicants understand Rehkopf to teach a system and method for optimizing end-to-end processing performance of a computer system by running benchmarks repeatedly using different values (Abstract). In particular, Rehkopf teaches that benchmarks are performed many times using different values for performance variables. Ultimately, the user is presented with a complete matrix of all values. Rehkopf does not teach, describe or suggest that “electronically deriving relationships over time between monitored system variables and monitored performance of said computer system,” as claimed.

Moreover, Applicants respectfully assert that the combination of Dumarot and Rehkopf not teach, describe or suggest “automatically generating a number of rules

based on said derived relationships, wherein said number of rules are generated without requiring human interaction,” as claimed because the references teach away from the suggested combination. As described above, and acknowledged by the Examiner, Dumarot teaches that rules are user-generated and user-selected.

Applicants respectfully submit that the rules of Dumarot are user-defined, and thus require human interaction. With reference to Figures 6 and 7, the placement of a rule icon determines whether a rule is applied (col. 8, line 28 through col. 9, line 39). For example, if the rule icon 540 is moved by a user within a threshold distance 590 from optimizer icon 510, the rule is applied, as shown at step 660 of Figure 7 (col. 9, lines 8-15). In particular, the selection rules how the rules are applied, as taught in Dumarot, requires human interaction. Moreover, Dumarot teaches a GUI for selecting and applying rules.

With reference to Figure 1 of Dumarot, icons representing rules are selected “from a set of available rules by the user and dragged 68 to an icon 69 representing the optimizer 136 so that the optimizer will implement 330, 340, 350 the rules” (col. 7, lines 50-53). Accordingly, Applicants respectfully assert that the rules as described in Dumarot are preconfigured and are not generated based on monitoring system variables and performance. Moreover, Dumarot teaches that a user selects the rules for implementation. Specifically, with reference to Figure 6 of Dumarot, the particular placement of a rule icon affects how the optimizer implements the rules (col. 8, line 26 through col. 9, line 4). The placement of the rule is a made by a user.

Applicants understand Dumarot to teach a system and method for optimizing computer software and hardware according to user-selected rules. Moreover, Applicants understand Dumarot to teach that the placement of the rules on the GUI (e.g., closeness) is used to determine how the rules are implemented. Specifically, the rules are not generated based on derived relationships of system variables and computer performance. While Dumarot does teach that the optimizer monitors system behavior, this monitoring is used for performing actions dictated by the rules, not for deriving relationships or generating rules.

Applicants understand Rehkopf to teach that variables are automatically altered during testing. During the performance of the optimization method, the computer system automatically varies the variables for the testing. In particular, the variables are varied during the benchmarking process, and are not based on or used in the automatic generation of rules.

Applicants respectfully assert that the combination of Dumarot view of Rehkopf does not teach, disclose, or suggest the invention as claimed. In contrast, Dumarot discloses a system and method for optimizing computer software and hardware according to user-selected rules and implements the rules according to how the icon representing the rule is placed in the GUI and Rehkopf teaches the automatic varying of variables during benchmarking. Moreover, by teaching a system that utilizes and requires a user to select and place rules for the rules to be applied, wherein the rules are pre-configured, Dumarot teaches away from the claimed invention. Furthermore, by teaching a system that utilizes and requires a user to select and place rules for the rules

to be applied, wherein the rules are pre-configured, Dumarot teaches away from the suggested combination with Rehkopf.

Applicants respectfully assert that nowhere does the combination of Dumarot in view of Rehkopf teach, disclose or suggest the claimed embodiments of the present invention as recited in independent Claims 1, 12, 14 and 24, and that these claims overcome the rejection under 35 U.S.C. § 103(a), and are in a condition for allowance. Therefore, Applicants respectfully submit that the combination of Dumarot in view of Rehkopf also does not teach, disclose or suggest the additional claimed features of the present invention as recited in Claims 2,3 and 5-11 that depend from independent Claim 1, Claim 13 that depends from independent Claim 12, Claims 15 and 17-23 that depend from independent Claim 14, and Claims 25 and 26 that depend from independent Claim 24. Applicants respectfully submit that Claims 2, 3, 5-11, 13, 15, 17-23, 25 and 26 also overcome the rejection under 35 U.S.C. § 103(a) as these claims are dependent on allowable base claims.

35 U.S.C. §103(a) - Claims 4 and 16

Claims 4 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dumarot in view of Rehkopf, further in view of the English Abstract of Japanese Patent 403010379 by Mihata et al., hereinafter referred to as the "Mihata" reference. Claim 4 depends from independent Claim 1 and Claim 16 depends from independent Claim 14. Applicants have reviewed the cited reference and respectfully submit that the embodiments of the present invention as recited in Claims 4 and 16 are patentable over the combination of Dumarot in view of Rehkopf, further in view of Mihata.

As described above in the discussion of the rejection of Claims 1-3, 5-15 and 17-26, the combination of Dumarot in view of Rehkopf teach, disclose or suggest the claimed embodiments of the present invention as recited in independent Claims 1 and 14. Moreover, the combination of Dumarot in view of Rehkopf, further in view of Mihata fails to teach or suggest the claimed embodiments because Mihata does not overcome the shortcomings of Dumarot in view of Rehkopf. Applicants understand Mihata to teach a design rules verifying system. Mihata, alone or in combination with Dumarot and Rehkopf, does not show or suggest a method for enhancing performance of a computer system, including “electronically deriving relationships over time between monitored system variables and monitored performance of said computer system,” or “automatically generating a number of rules based on said derived relationships, wherein said number of rules are generated without requiring human interaction,” as claimed.

Applicants respectfully assert that nowhere does the combination of Dumarot in view of Rehkopf, further in view of Mihata, disclose or suggest the present invention as recited in independent Claims 1 and 14, and that Claims 1 and 14 are thus in condition for allowance. Therefore, Applicants respectfully submit that the combination of Dumarot in view of Rehkopf, further in view of Mihata also does not teach or suggest the additional claimed features of the present invention as recited in Claim 4 that is dependent on allowable base Claim 1 and Claim 16 that is dependent on allowable base Claim 14. Applicants respectfully submit that Claims 4 and 16 overcome the

rejection under 35 U.S.C. § 103(a) as these claims are dependent on allowable base claims.

Applicants respectfully point out that the rejections based only on Mihata are based only on the Abstract of Mihata, which is the only portion of Mihata that is translated into English. "Citations of an abstract without citation and reliance on the underlying scientific document itself is generally inappropriate where both the abstract and the underlying document are prior art. ... It is our opinion that a proper examination under 37 CFR §1.104 should be based on the underlying documents and translations, where needed. Accordingly, the preferred practice is for the examiner to cite and rely on the underlying document." *Ex parte Jones*, 62 USPQ2d 1206, 1208 (B.P.A.I. 2001). "In our view, obtaining translations is the responsibility of the examiner. A review by the examiner and applicant of translations of the prior art relied upon in support of the examiner's rejection may supply additional relevant evidence as to whether there is a legally sufficient reason, suggestion, teaching or motivation to combine the teachings *Ex parte Jones*, 62 USPQ2d 1206, 1208-09 (B.P.A.I. 2001); MPEP 706.02.

In the event that Mihata is again cited by the Examiner in rejecting the claims, in order to fully appreciate the scientific teachings of Mihata, Applicants request that the Examiner provide a complete translation of Mihata in order to fully understand its teachings.

CONCLUSION


Based on the arguments presented above, Applicants respectfully assert that Claims 1-26 overcome the rejections of record and, therefore, Applicants respectfully solicit allowance of these Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

WAGNER, MURABITO & HAO L.L.P.

Dated: 10/24/, 2005



John P. Wagner
Registration No. 35,398

Two North Market Street
Third Floor
San Jose, CA 95113
(408) 938-9060